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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,809	03/30/2004	Jeffrey Hutterer		6034
45096 7590 03/24/2009 STEVEN HOROWITZ, ESQ. 295 MADISON AVE SUITE 700 NEW YORK, NY 10017			EXAMINER CARTER, KINDRA D	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 03/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,809

Applicant(s)

HUTTERER, JEFFREY

Examiner

KENDRA D. CARTER

Art Unit

1617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-20 and 26-42 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-20, 26-35, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges the applicant's remarks and arguments of January 15, 2009 made to the office action filed August 21, 2008. Claims 1-6, 12-20 and 26-42 are pending. Claims 1, 6, 27 and 29-31 are amended. In a restriction filed October 31, 2007, Applicant elected claims 1-35, in which claims 36-40 were withdrawn.

For the reasons in the previous office action and below, the Applicant's arguments of the 35 U.S.C. 103(a) rejection of claims 1-6, 12-20, 26-35 and 41-42 as being unpatentable over Roberts et al., in view of Platt, McCadden, O'Kane et al., and Healthchemist, were found not persuasive, thus the rejection is upheld.

In light of the amendments to the claims the new 35 U.S.C. 112, first paragraph rejection and the modified 35 U.S.C. 103(a) rejection is below. The Applicant's arguments are addressed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6, 27 and 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, the specification does not require a specific ratio between the corticosteroid or the antihistamine. Even in the examples, the ratios between the corticosteroid and the antihistamine do not match those claimed. For instance, in example 1, the Applicant's claim that there is roughly a 1:2 ratio of hydrocortisone to antihistamine, which is not "less than 1:1" as disclosed in claim 1. Further, Example one does not exemplify a less than 1:2 ratio of corticosteroid to antihistamine because the amounts given in Example 1 are approximately made. Thus, the amount can be more or less than 0.1 grams which will ultimately effect the ratio. In regards to the ratio of approximately 1:40, the Applicant provides Example VIII to demonstrate the support in the specification for this ratio. The Examiner does not agree that Example VIII demonstrates a ratio of approximately 1:40 corticosteroid to antihistamine. Particularly, the estimated amounts of the antihistamine should be around 0.0002 g (0.0032×0.06 mL) not 0.002 g, which does not give a 1:40 ratio to the estimated amount of 0.00005 g of corticosteroid (0.1 g of a 0.05% corticosteroid).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 12-20, 26-35 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (US 5,750,141), in view of Platt (WO 98/10647 A1), in view of McCadden (US 6,479,058 B1), in view of O'Kane et al. (The Physician and sports medicine, September 1999, vol. 27(9), pp. 1-14) in further view of Healthchemist (online pharmacy printout of Naphcon being sold).

Roberts et al. teach a method of topical and/or transdermal administration of a vaso-active agent administered in combination with a therapeutic agent which is useful in treatment of the dermis epidermis, wherein the therapeutic agent may be administered in a similar manner in combination with the vaso-active agent or may be administered separately so as to increase local perfusion and/or concentration of the therapeutic agent at the administration site of the vaso-active agent (see abstract and claim 1; addresses claims 1 and 27). The composition may also include a suitable vehicle or carrier (see column 6, lines 35-36). Therapeutic agents include corticosteroids such as hydrocortisone and dexamethasone, and antihistamines. (see

column 6, lines 39, 40, 49, 53, 54 and 55; see column 6, line 52; addresses 1, 6, 20, 27, 29-34). Suitable vasoconstrictors include naphazoline (i.e. decongestant) and phenylephrine hydrochloride (i.e. decongestant; see column 7, lines 33, 41, 42 and 43; addresses claims 1, 3-5, 14-19 and 27).

Roberts et al. does not teach pheniramine maleate, the amounts of the combination solution (claims 1, 2, 3, 4, 5, 13-19, 27 and 28), the ratio of the corticosteroid cream and the antihistamine (claims 1, 6, 27 and 29-31), the amounts of the corticosteroid cream (claims 13 and 27), specifically a 1% cream of hydrocortisone (claims 12, 26 and 35).

Pratt teaches a topical preparation of an antihistaminic chemical compound and at least one hydrocortisone compound to treat various types of dermatitis (see abstract and title). The antihistamine can be pheniramine maleate (see page 7, line 19; claim 3). The combination effectively treats dermatitis caused by a noxious agent or by an allergic reaction much quicker and with deep penetration and time release features making it more effective than either over-the-counter or prescription preparations (see page 6, second paragraph in its entirety.)

McCadden teach a composition for the topical treatment of skin eruptions from psoriasis (see title and column 1, lines 19 and 20) comprising a corticosteroid of appropriate potency for the condition being treated (see column 2, lines 50-53) in the

form of a cream (see column 2, last line). Low potency steroids are generally preferred in view of certain disadvantages of high potency steroids such as hydrocortisone, most preferably from about 0.5 to about 2.5% (see column 4, lines 63-65 and column 5, lines 8-10). The composition is applied topically to the involved area until it has healed (see column 10, lines 11-12).

O'Kane et al. teach topical vasoconstrictors for the treatment of allergic conjunctivitis including the application of 1 drop of a 0.1% solution of Naphazoline HCl and pheniramine maleate, also known as Naphcon-A (see page 5, table 2, see page 6, topical vasoconstrictors, third entry).

Healthchemist teaches that the Naphcon-A product comprises 0.25 mg/ml of naphazoline hydrochloride and 3 mg/ml of pheniramine maleate (see active ingredients).

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the method steps and composition of Roberts et al. and the combination of pheniramine maleate with either naphazoline HCl or phenylephrine HCl because of the following teachings: (1) Pratt teaches a topical preparation of an antihistaminic chemical compound and at least one hydrocortisone compound to treat various types of dermatitis (see abstract and title).; (2) Pratt teaches that the combination effectively treats dermatitis caused by a noxious agent or by an

allergic reaction much quicker and with deep penetration and time release features making it more effective than either over-the-counter or prescription preparations (see page 6, second paragraph in its entirety); and (3) "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960); *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992); and *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987).

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the method steps and composition of Roberts et al. in view of Platt and the specific 1% cream of hydrocortisone (claims 12, 26 and 35) because McCadden teach a composition for the topical treatment of skin eruptions from psoriasis (see title and column 1, lines 19 and 20) comprising from about 0.5 to about 2.5% of the hydrocortisone cream (see column 2, lines 50-53; column 2, last line; column 4, lines 63-65 and column 5, lines 8-10). Thus, psoriasis is effectively treated with a 1% hydrocortisone cream. Therefore, one would be motivated to use this concentration of hydrocortisone for the method of Roberts et al. in view of Platt.

In regards to the actual amount of cream applied as disclosed in applicant's claims 13 and 27, it would be obvious to apply approximately 0.05 grams to approximately 0.2 grams because McCadden teaches that the hydrocortisone composition is applied topically to the involved area until it has healed (see column 10, lines 11-12). Thus, the amount to cover the area can comprise approximately 0.05 grams to approximately 0.2 grams, depending on the size of the area to be treated.

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the method steps and composition of Roberts et al. in view of Platt and the amounts of the combination solution (claims 1, 2, 3, 4, 5, 13-19, 27 and 28) because of the following teachings: (1) O'Kane et al. teach topical vasoconstrictors for the treatment of allergic conjunctivitis including the application of 1 drop of a 0.1% solution of Naphazoline HCl and pheniramine maleate, also known as Naphcon-A (see page 5, table 2, see page 6, topical vasoconstrictors, third entry); (2) Healthchemist teaches that the Naphcon-A product comprises 0.25 mg/ml of naphazoline hydrochloride and 3 mg/ml of pheniramine maleate (see active ingredients); and (3) It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art." See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994);

In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Paterson* Appeal No. 02-1189 (Fed. Cir. January 8, 2003). Thus, a combination of a decongestant and an antihistamine is known in the applicant's disclosed ratios and applied in the amounts of a volume of at least approximately 0.02 ml (1 to 2 drops). One skilled in the art can determine the amount needed to treat the affected area.

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the method steps and composition of Roberts et al. in view of Platt and the ratio of the corticosteroid cream and the antihistamine as disclosed in claims 1, 6, 27 and 29-31 because one skilled in the art would be able to determine the effective amount of each component through standard tests. The motivation is to provide effective treatment for the dermatitis. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

In regards to the method relieving or alleviating symptoms within approximately two to four minutes, or that the symptoms last for approximately two to five hours, the Examiner renders the above limitations obvious over the above references. Roberts et al. teach a method useful in treatment of the dermis epidermis in which the method can be adopted to prolonged periods of 2-12 hours (see column 7, lines 9-10). Since all references teach a method of treatment, it is viewed by the Examiner that the symptoms

of the dermatitis is relieved or/and alleviated. In regards to the time factor, both Roberts et al. and Pratt describe that the methods used increase the effectiveness time by increasing penetration. Thus, one skilled in the art would anticipate that the combination would produce shorter relief times than the drugs individually as stated by Pratt (see page 6, second paragraph in its entirety.)

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

The Applicant argues that Platt teaches that if the ratio of the hydrocortisone to the antihistamine is 4:3 and not more or less the addition of hydrocortisone, rather than decreases, actually greatly increases the absorption rate of the diphenhydramine (see page 6, last paragraph). Platt also teaches that the antihistamine could also be pheniramine maleate (see page 7). In direct contradiction to Platt and the prior art, the present invention, based on experimentation, achieves a dramatic increase in effectiveness and speed by adding pheniramine maleate to hydrocortisone well outside the 4:3 ratio and together with 1 of 2 decongestants –the absorbability and antihistamine effectiveness is increased. Thus, Platt specifically teaches away from the current invention as demonstrated in Examples I and VIII. Further, Robert contradicts himself in column 6, lines 15-24 versus column 6, lines 25-31. Robert states that vasodilators help remove therapeutic agents and help deeper penetration of the skin by the therapeutic agent, and then states that vasoconstrictors decrease the rate that the therapeutic agent is cleared away/removed which increases the depth of tissue penetration of the therapeutic agent. Both statements cannot be true. It is unlikely that the invention of Roberts really works with both vasoconstrictors and vasodilators.

The Examiner disagrees because Platt is not the primary reference and is used to teach why one would combine a corticosteroid with an antihistamine, particularly, the combination of pheniramine maleate with either naphazoline HCl or phenylephrine HCl. Platt does not teach away from the current invention because the administration techniques of the Platt reference and the Roberts reference are different. In the Roberts reference the corticosteroid is applied separately from the antihistamine and carriers can be used (see abstract; claim 1; column 6, lines 35-36). Platt uses the hydrocortisone as a carrier (see page 8, second paragraph) when combined with the antihistamine. Further the studies performed by Platt in regards to the ratio were specific to diphenhydramine not all antihistamines (see page 8, paragraph 3). In regards to the teachings of Robert and the vasoconstrictor or vasodilator, Robert teaches the combination of a vaso-active agent (see claim 1) which can be a vasodilator or vasoconstrictor. Both independently act as an vaso-active agent that facilitates faster delivery of the therapeutic agent (see column 6, lines 7-31).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENDRA D. CARTER whose telephone number is (571)272-9034. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kendra D Carter/
Examiner, Art Unit 1617

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617